

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 51

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINKICHI KOBAYASHI and YOSHIO SAEKI

Appeal No. 2000-2158
Application No. 08/741,226

ON BRIEF

Before THOMAS, RUGGIERO, and DIXON, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 13 through 16.

Representative claim 13 is reproduced below:

13. A disc cartridge for enclosing an optical disc comprising:

a cartridge body having first and second halves and for accommodating said optical disc in which said optical disc has a diameter of approximately 64 mm;

said first half having a generally rectangular shape and having a first opening for inserting a disc rotational driving means and a second opening to allow passage of a light beam to said optical disc, and wherein a recess is formed along one side of said first half;

said second half formed in a generally rectangular shape and having a flat outer surface on which a label may be affixed and without an opening, and wherein said second half is connected to said first half thereby defining a space to accommodate said optical disc;

a guide groove formed on one lateral side edge of said cartridge body, said guide groove constituting a recess portion on said first half and one side portion of said second half, said guide groove having an opening portion for inserting a shutter opening means;

a mis-insertion inhibit groove formed on a lateral side of said cartridge body opposite to said lateral side containing said guide groove;

a shutter member mounted on only said first half of said cartridge body for opening and closing said second opening, wherein said shutter member is moveable along said guide groove by said inserted shutter opening means, said shutter member having a continuous plate portion having a substantially T-shape with two arms for opening and closing said second opening and an engaging means for holding said shutter member to an edge portion of one side of said cartridge body, said engaging means including an upstanding portion formed on said plate portion to form a generally L-shaped cross section, a plurality of engaging portions formed on said upstanding portion, and at least one projection formed on one of said two arms of said plate portion, said projection extending at a right angle from said plate portion and engaged to said recess; and

wherein said plate portion, said upstanding portion, said engaging portions, and said projection operate together to hold and to prevent disengagement of said shutter member from said cartridge body.

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The following references are relied upon by the examiner:

Sakuyama ¹	4-34784	Feb. 05, 1992
(published Japanese Kokai patent Application)		
Takahashi	EP 0 526 222 A2	Feb. 03, 1993
(published European Patent Application)		

Claims 13 through 16 stand rejected under 35 U.S.C. § 103.
As evidence of obviousness, the examiner relies upon Takahashi in view of Sakuyama.

Rather than repeat the positions of the appellants and the examiner, reference is made to the brief and reply brief as well as the answer for their respective positions.

OPINION

We reverse.

Each of independent claims 13 and 14 on appeal recite "a mis-insertion inhibit groove formed on a lateral side of said cartridge body opposite to said lateral side containing said guide groove."

The examiner asserts at page 4 of the answer that Takahashi does not show this feature, and our study of Takahashi as well as Sakuyama leads us to conclude that neither reference relied upon

¹Our understanding of this reference is based upon a translation provided by the Scientific and Technical Information Center of the Patent and Trademark Office. A copy of this translation is enclosed with this decision.

teaches or shows this claimed mis-insertion inhibit groove. As to this feature, the examiner takes Official Notice of it at the bottom of page 4 of the answer asserting "that placing a mis-insertion inhibit groove on a side of a cartridge that is perpendicular to the inserting side of the cartridge is notoriously old and well known in the art." The examiner goes on in the reasoning in the answer at pages 4 and 5 to conclude the obviousness of combining that feature asserted to be old in the art with Takahashi.

Even though the appellants do not contest this assertion in the brief and reply brief, we are constrained to reverse the outstanding rejections because there is no evidence before us of this feature among the references relied upon by the examiner in formulating the rejection. Essentially, we conclude the examiner has not set forth a prima facie case of obviousness. We reach this conclusion based upon the reasoning provided by recent cases from our reviewing court. "[T]he Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In

re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002). The court in Lee requires evidence for the determination of unpatentability by clarifying that "common knowledge and common sense," as mentioned in In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969), may only be applied to analysis of the evidence, rather than be a substitute for evidence. Lee, 277 F.3d at 1345, 61 USPQ2d at 1435. See Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc., 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999) (Bozek's reference to common knowledge "does not in and of itself make it so" absent evidence of such knowledge).

Although we do not have before us an assertion of common knowledge and common sense in the art as in In re Lee, the examiner has made an analogous assertion that the feature of a mis-insertion inhibit groove was notoriously old and well known in the art. Correspondingly, the examiner's assertion appears to us to be a substitute for actual evidence to prove the examiner's assertion. More recently, however, the court expanded its reasoning in In re Thrift, No. 01-1445 (Fed. Cir. Aug. 9, 2002).

Since the examiner has stated at the bottom of page 4 of the answer that "placing a mis-insertion inhibit groove on a side of a cartridge that is perpendicular to the inserting side of the

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cartridge is notoriously old and well known in the art," the examiner should have no trouble finding and/or selecting appropriate prior art evidencing this feature and properly applying it in a new rejection within 35 U.S.C. § 103. Taken in this light, this application is therefore remanded to the examiner for such consideration pursuant to 37 CFR § 1.196(a) and the Manual of Patent Examining Procedure (MPEP) § 1211.

REVERSED and REMANDED

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
JOSEPH F. RUGGIERO)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

JDT:hh

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